



04-16-04 Image

1743

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANT(S):	Robert P. Otillar et al.
APPLICATION NO.:	09/683,861
FILING DATE:	February 22, 2002
TITLE:	System and Methods for Localizing and Analyzing Samples on a Bio-Sensor Chip
EXAMINER:	Ludlow
GROUP ART UNIT:	1743
ATTY. DKT. NO.:	None
CERTIFICATE OF MAILING/TRANSMISSION I hereby certify that this correspondence is being deposited on the date shown below with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Dated: 4/14/04 By: <u>R. Otillar</u> Robert P. Otillar	

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

SIR:

Responsive to the Office Action dated January 15, 2004 received in the above-identified patent application, Applicants elect Group III (claims 39-41) with traverse. Included with this Response is a Request for Extension of Time for 2 months accompanied by the appropriate fee. This Response is "timely filed." Applicants respectfully request consideration of the claims in the above-identified application for the purpose of putting the application in condition for allowance.

A restriction requirement is proper where more than one invention is claimed and the inventions are independent or distinct, and failure to restrict imposes a serious burden on the examiner. See MPEP at 803. In the instant case, Examiner improperly restricted the claims as defined in the Office Action of January 15, 2004.

According to the MPEP, section 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes

claims to independent or distinct inventions.” In the Office Action of January 15, 2004, Examiner divided the invention into four separate Groups stating that the Groups have “acquired a separate status in the art as shown by their different classification.” However, three of the Groups, (Groups I, II, and IV) are listed by the Examiner as being not only in the same class, but also in the same subclass. Thus, these Groups could not have “acquired a separate status in the art as shown by their different classification.” According to the MPEP section 808.02, “separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.” The Examiner did not cite any patents in the response of January 15, 2004.

Additionally, the Examiner has given no explanation for why Group III is listed as a separate class and subclass from Groups I, II, and IV. According to the MPEP section 808.02, the Examiner “must show by appropriate explanation” the separate classification of the identified Groups. Thus, the Examiner must show that “each distinct subject has attained recognition in the art as a separate subject for inventive effort and also a separate field of search.” The Examiner has provided no explanation for the classification imposed on Group III, or the classification imposed on Groups I, II, or IV. The Examiner has not provided support showing that the four Groups have acquired a separate status in the art, nor has the Examiner indicated that the Groups require different fields of search. Therefore, restriction was improper and should be withdrawn.

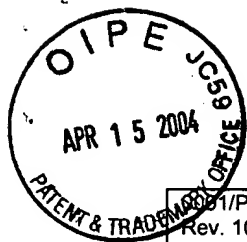
Consideration of the claims is respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, please contact the Applicant at (415) 317-2008.

Respectfully submitted,



ROBERT P. OTILLAR

Dated: 4/14/04



+

TRANSMITTAL FORM <i>(to be used for all correspondence during pendency of filed application)</i>		Application Number	09/683,861
		Filing Date	02/22/02
		First Named Inventor	Storek
		Group Art Unit Number	1645
		Examiner Name	Ludlow
Total Number of Pages in This Submission	6	Attorney Docket Number	none

ENCLOSURES (check all that apply)	
<input checked="" type="checkbox"/> Fee Transmittal Form (in duplicate) <input type="checkbox"/> Check Enclosed	<input type="checkbox"/> Issue Fee Transmittal
<input checked="" type="checkbox"/> Return Receipt Postcard	<input type="checkbox"/> Letter to Chief Draftsperson
<input type="checkbox"/> Response to Notice to File Missing Parts	<input type="checkbox"/> Formal Drawing(s): [] Sheet(s) of Figure(s) []
<input type="checkbox"/> Assignment & Recordation Cover Sheet	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Declaration	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Power of Attorney	<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Application Data Sheet	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Information Disclosure Statement & PTO/SB/08A <input type="checkbox"/> Copies of IDS Cited References	<input checked="" type="checkbox"/> Response to Restriction Requirement
<input type="checkbox"/> Request for Corrected Filing Receipt	<input type="checkbox"/> _____
<input type="checkbox"/> Request for Correction of Recorded Assignment	<input type="checkbox"/> _____
<input type="checkbox"/> Amendment/Response: [] Page(s) <input type="checkbox"/> After Final	<input type="checkbox"/> _____
<input type="checkbox"/> Status Request	<input type="checkbox"/> _____
<input type="checkbox"/> Revocation and Substitute Power of Attorney	<input type="checkbox"/> _____
REMARKS:	

SIGNATURE OF ATTORNEY OR AGENT		
Signature:		
Attorney/Reg. No.:		Dated: 4/14/04

CERTIFICATE OF MAILING		
I hereby certify that this correspondence, including the enclosures identified above, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. If the Express Mail Mailing Number is filled in below, then this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service pursuant to 37 CFR 1.10.		
Signature:		
Typed or Printed Name:	Robert A. Miller	Dated: 4/14/04
Express Mail Mailing Number (optional):		



FEE TRANSMITTAL for FY 2004

Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 210.00

Complete if Known

Application Number 09/683,861

Filing Date 02/22/2002

First Named Inventor Otilar

Examiner Name Ludlow

Art Unit 1743

Attorney Docket No. None

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit Card ☐ Money Order ☐ Other ☐ None
☐ Deposit Account:

Deposit Account Number

Deposit Account Name

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments

☐ Charge all required fee(s) or any underpayment of fee(s) due under 37 CFR §1.16 or §1.17 during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee

to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
	-20**=	X	=
Independent Claims	-3**=	X	=
Multiple Dependent			=

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	210
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(g)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

SUBTOTAL (3) (\$) 210.00

*Reduced by Basic Filing Fee Paid

SUBMITTED BY

Name (Print/Type)	Robert Otilar	Registration No. (Attorney/Agent)		Complete (if applicable)	Telephone 415-317-2068
Signature	RPA			Date	4/14/04